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Att'y Docket No. SAF 41 111

PATENT

Serial No.: 08/554,315
Filed: November 8, 1995
Art Unit: 1513
Examiner: Merrick Dixon
Applicant: John Mahn, Jr.
Title: **Heat Activated Applique on Pressure Sensitive Release Paper and Method of Making**

Cincinnati, Ohio 45202 January 21, 1997

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE

In response to the Office Action dated November 25, 1996, Applicant requests reconsideration.

In the response to the preceding Office, Applicant pointed out that the numerals "10" and "12" are reversed at column 3 of the *Powers* reference. The Examiner indicated no modification of the cited reference for any purpose is considered appropriate. In light of this, Applicant now maintains that the *Powers* reference is inoperative. At the first line of column 3, *Powers* refers to "paper 12." Then, at line 28, it refers to "paper 10." At column 2, line 67, it refers to "indicia 10."

Therefore, *Powers* discloses a complete mish-mash that has no meaning whatsoever. One cannot pick and choose the appropriate meanings of the terms to meet his purpose and ignore the remaining meanings and terms in a patent. The reference has to be considered as a whole. Therefore, Applicant maintains that the *Powers* reference must either be discounted in its entirety, or conclude -- as Applicant did -- that the numerals are reversed.

The Examiner also indicated that he was not sure about Applicant's contention with reference to the *Mahn* reference. Accordingly, Applicant has enclosed herewith the Declaration of John Mahn, Jr., an inventor in the cited reference. The Declaration provides specific embodiments of the materials disclosed in the cited portions of the references. This confirms Applicant's position and accordingly, Applicant would request reconsideration. Further, this reference is not prior art to applicant. Applicant's effective filing date is April 14, 1994. Accordingly, this reference shoujld not be considered.

Finally, with respect to Applicant's position that incorporating cut lines in the *Powers* reference would not function in the same manner as Applicant's invention, the Examiner maintained that the burden of proof shifted to Applicant. However, the MPEP clearly indicates that the burden of proof in establishing a prima facie case of obviousness rests with the Examiner. As stated as Section 2142:

> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done . . . . With regard to rejections under 35 U.S.C. § 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not.

Applicant questions the prima facie case of obviousness. Until that is established, the burden remains with the Patent and Trademark Office. As indicated, the indicia shown in Fig. 12 in *Powers* reference has discrete printed indicia. Applicant starts with a continuous layer that has no indicia and cuts through the lines to establish the discrete indicia. Applicant further maintains that if one were to cut through layer 14 and layer 16 down to layer 24 of the article shown in Fig. 12 of *Powers*, the indicia may not have sufficient adhesion to remain affixed to layer 22 since layer 24 is a release layer, as opposed to a pressure sensitive adhesive layer. In other words, Applicant is maintaining

that there is no disclosure in the *Powers* reference of an adhesion layer. There is no contention that any of these underlying statements are inaccurate. Therefore, no testing is required.

Further, since Applicant has shown through the attached Declaration that the *Mahn* reference does not disclose a cut line through the heat-activated adhesive layer and the indicia layer, but not through the support layer, this element of Applicant's invention is not present in any of the cited references. In other words, the cited references cannot establish a prima facie case of obviousness. As indicated, Applicant has set forth the Declaration of John Mahn to show what this prior art includes to further emphasize this point.

In light of this, Applicant would maintain that the present invention is not suggested by the cited *Powers* and *Mahn* references and accordingly would request allowance of the pending claims.

Respectfully submitted,

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By: _____

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